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10/765,501	01/26/2004	David Eugene Huddleston	DEH1001	2563

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EXAMINER

BUI, LUAN KIM

ART UNIT PAPER NUMBER

3728

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/765,501  
Filing Date: January 26, 2004  
Appellant(s): HUDDLESTON, DAVID EUGENE

**MAILED**  
**OCT 13 2006**  
**GROUP 3700**

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David Huddleston  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 8/21/2006 appealing from the Office action mailed 1/20/2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-5, 7, 9, 11-17 and 19. Claims 2 and 3 have not been amended from their original wordings.

Claims 6, 8, 10, 18 and 20 have been canceled.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

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**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claims 1-5, 7, 9, 11-17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (as per attached).

Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindheim (213,580) in view of Tabler (665,942). (as per attached).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Kahl (2005/0072698). (as per attached).

Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 1 above, and further in view of Furlow et al. (4,974,709; hereinafter Furlow'709). (as per attached).

Claims 11-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 5 above, and further in view of Janssen (4,215,629). (as per attached).

Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 11 above, and further in view of Pollak et al. (3,225,806; hereinafter Pollak'806). (as per attached).

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**8) Evidence Relied Upon**

213,580	LINDHEIM	3-1879
665,942	TABLER	1-1901
4,974,709	FURLOW ET AL.	12-1990
4,215,629	JANSSEN	8-1980
3,225,806	POLLAK ET AL.	12-1965
2005/0072698	KAHL	4-2005

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Information Disclosure Statement***

1. The information disclosure statement filed 3/29/2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because most of the non patent literature documents do not include title of the article, date (the article was printed on ...), number of page (s) .

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-5, 7, 9, 11-17 and 19 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject

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matter which applicant regards as the invention. The phrases "1.a." (two places) and "1.a.," (two places), "opened.," "bag." in claim 1 and "unit.," "opening." "open." in claim 11 are incomplete and indefinite. The phrases "a drawstring" in claim 1, line 7 and "a stiff wire-like means" in claim 11, line, 8 is double recitation of line 5. Claims 12-17 and 19 depend from the canceled claim 10. In claims 7 and 17, the phrase "permits the identification card to be kept visible" is confusion and indefinite because it has no clear meaning as to how to be kept visible?

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1, 2 and 4 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Lindheim (213,580) in view of Tabler (665,942). Lindheim discloses a carrier (A) comprising a suitably sized bag of flexible material formed from one or more panels of material and the bag having a flared opening when the bag is fully opened (Figure 2), a means to serve and mate as a

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drawstring (C, D) for closing and opening the bag (Figures 1-3). The bag of Lindheim is capable of holding a cell phone. Lindheim also discloses the other claimed limitations except for one or more handles being attached near the edge of the opening. Tabler teaches a bag (A) comprises one or more handles (23) for handling the bag. It would have been obvious to one having ordinary skill in the art in view of Tabler to modify the bag of Lindheim so the bag includes one or more handles attached near the edge of the opening for handling the bag such as for carrying the bag. The handle of the bag of Lindheim as modified is capable for using to open the bag. As to claims 2 and 4, the bag of Lindheim is capable to hold any of a variety of small electronic items as claimed.

4. Claim 3 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Kahl (2005/0072698). Lindheim as modified further fails to show the carrier comprises indicia. Kahl teaches a bag having a graphic indicia (Figure 4 and claim 7). It would have been obvious to one having ordinary skill in the art in view of Kahl to modify the bag of Lindheim as modified so it includes indicia for decorative purposes.

5. Claims 5 and 9 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 1 above, and further in view of Furlow et al. (4,974,709; hereinafter Furlow'709). Lindheim as modified further fails to show an attaching means being affixed to the end of the drawstring means. Furlow'709 shows a bag (10) having an attaching means (87, 89) affixed to the end of the straps (86, 88) (Figure 5) and clasping means (44) assembled onto the

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drawstring (Figure 4). It would have been obvious to one having ordinary skill in the art in view of Furlow'709 to modify the bag of Lindheim as modified so the end of the drawstring means includes an attaching means to facilitate attaching the bag to another object or folding the bag for storage. The bag of Lindheim as modified with the attaching means and the attaching means is capable for attaching the bag to the user's clothing such as a belt.

6. Claims 11-16 and 19 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 5 above, and further in view of Janssen (4,215,629). Lindheim further fails to show the carrier comprises a stiff wire like means in lieu of the drawstring and a clasping means being assembled onto the stiff wire-like means. Janssen teaches a bag (282) having an opening (308) and a stiff wire-like means (303) (column 7, lines 16-23) for closing the opening or to maintain the opening in an open position (Figure 7). It would have been obvious to one having ordinary skill in the art in view of Furlow'709 and Janssen to modify the bag of Lindheim so the drawstring comprises a stiff wire-like means as taught by Janssen to maintain the shape of the opening in an open position and to facilitate inserting and/or removing items from the bag and the bag further includes a clasping means as taught by Furlow'709 for better securing the opening. As to claim 13, see claim 3 above. As to claim 14, see claim 4 above. As to claim 15, see claim 5 above. As to claim 16, see claim 1 above. As to claim 19, see claim 9 above.

7. Claims 7 and 17 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 11 above, and further in view of Pollak et al.

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(3,225,806; hereinafter Pollak'806). Lindheim further fails to show the bag comprises an external holder. Pollak'806 shows the bag (20) having an external holder (23, 24) (Figure 1). It would have been obvious to one having ordinary skill in the art in view of Pollak'806 to modify the bag of Lindheim so it includes an external holder to facilitate holding an additional item such as an identification card. It would have been obvious to one having ordinary skill in the art in view of Lindheim as modified so the external holder formed from a transparent material to allow visual access to the contents within the holder since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

#### **(10) Response to Argument**

1. With respect to the information disclosure statement, Appellant is requested to review both Office Actions mailed on 9/8/2005 and 1/20/2006 because the Examiner's position is not in contradiction to various Patent Office rules. For example, In MPEP, under 37 CFR 1.98(b)(5) states "Each publication listed in an information disclosure statement must be identified by publisher, author (is any), title, relevant pages of the publication, date and place of publication." and also see in MPEP, 707.05 (e). The Non Patent Literature documents were not considered by the Examiner because Appellant fails to comply with the Patent Office rules. Also, this is a non-appealable matter.

2. Appellant's arguments with respect to this section are noted. They are not understood because the claims as presented are replete with indefinite language for failing to

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particularly point out and distinctly claim the subject matter which Appellant regards as the invention. For example, the phrases “1.a.” or 1.a.,” or “opened.” and others are incomplete and indefinite because each claim should begin with a capital letter and end with a period. Periods may not be used elsewhere in the claims except for abbreviations. See *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995) and also see MPEP 608.01(m). Accordingly, Appellant fails to comply with the Patent Office rules.

3. Appellant's arguments with respect to claims 1, 2 and 4 are noted. They are not persuasive because it is old and conventional in the art for providing a bag comprises one or more handles to facilitate carrying the bag. Tabler teaches a bag having one or more handles to handling the bag. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there does not appear to be anything unobvious about using the teaching of providing one or more handles as suggested by Tabler in the bag of Lindheim to facilitate handling the bag. The bag includes one or more handles of Lindheim as modified are capable for using the open the bag by pulling the handles apart.

In response to Appellant's argument that “to use the result as a cell phone carrier”, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

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invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the bag of Lindheim as modified is capable to be used for carrying a cell phone.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

4. Appellant's arguments with respect to Kahl for rejecting claim 3 are noted. They are not persuasive because Kahl is relied upon for providing a bag or carrier with indicia and nothing more. It would have been obvious to one having ordinary skill in the art using the teaching of Kahl to modify the bag of Lindheim as modified so the bag includes indicia for decorative purposes.

5. Appellant's arguments with respect to claims 5 and 9 are noted. They are not persuasive because providing a bag comprises attaching means affixed to the end of the straps and clasping means assembled onto the drawstrings is old and taught by Furlow to allow the user

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to attach the bag to the user's clothing or to a belt or belt loop to facilitate transporting the bag.

It would have been obvious to one having ordinary skill in the art in view of Furlow'709 to modify the bag of Lindheim as modified so the end of the drawstring means includes an attaching means to facilitate attaching the bag to another object.

6. The new citation was necessitated by the Appellant's amendment filed on 12/1/2005 because the phrase "stiff wire-like means" in the amendment is not the same as "draw-wire means" as originally filed and "stiff wire like means" in the amendment is not the same as "incompressible means" as originally filed.

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). In this case, to the extent that the Examiner can determine the scope of the claims, each of the reference is relied upon for the rejection of the claims related to a bag for holding an article. Therefore, all the references are in the field of Appellant's endeavor which is capable for holding a cell phone.

As to claim 12, it would have been obvious to one having ordinary skill in the art at the time the invention was made to re-scaled the bag of Lindheim to accommodate items larger or smaller than cell phones since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

As to claim 13, Kahl teaches the bag having indicia.

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As to claim 14, the bag of Lindheim is capable to be used for carrying eyeglasses or others.

As to claims 15 and 19, Furlow'709 shows an attaching means (87, 89) affixed to the end of the drawstrings means and the attaching means is capable to attach to a belt or strap.

As to claim 16, Tabler shows the bag comprises one or more handles.

There does not appear to be anything unobvious about using the teaching of the secondary references to modify the primary reference, Lindheim, to include the features as taught by the secondary references to provide more convenience for the user.

7. Appellant's arguments with respect to claims 7 and 17 are noted. They are also not persuasive because it is old and conventional practice for providing a bag with an external card holder and such bag is taught by Pollak et al. It would have been obvious to one having ordinary skill in the art to modify the bag of Lindheim so the bag includes an external holder as taught by Pollak et al. for holding an additional item on the outer surface of the bag to provide more convenience for the user and it would also have been obvious to one having ordinary skill in the art in view of Lindheim as modified so the external holder formed from a transparent material to allow visual access to the contents within the holder since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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8. Tabler shows the bag may be made of any desired material (page 1, lines 42-44) which is considered equivalent to a stretchable material as claimed and Lindheim discloses the flared opening (page 1, column 2, line 5).

9. Tabler shows the one or more handles attached near the opening of the bag as claimed.

10. With respect to this section, the Examiner is not understood the Appellant's argument since the Appellant is the one who fails to comply with the Patent Office rules.

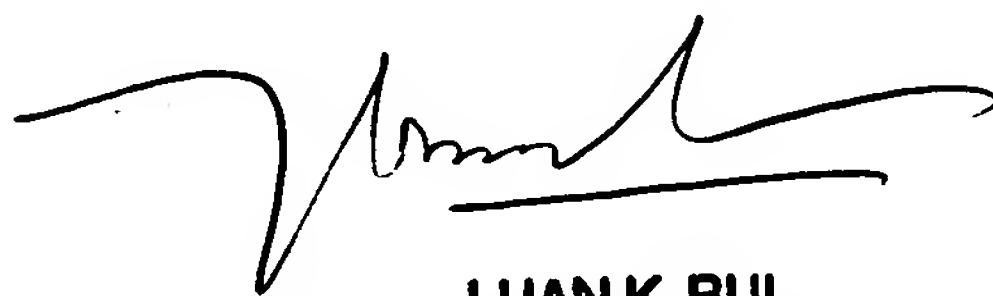
**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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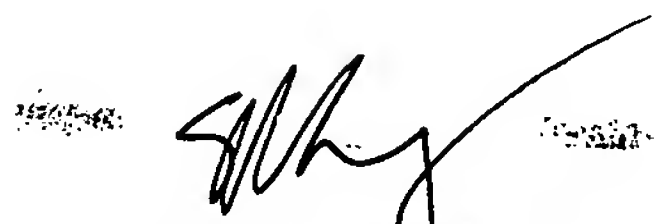
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

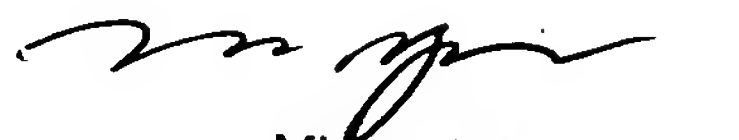


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